REMARKS

Applicants acknowledge the correction of the inventorship pursuant to 37 C.F.R. 1.48(a) to delete Patrick A. Schneider and to add Said L. Shami. As explained in more detail below, corresponding papers to correct inventorship have been filed in the issued U.S. Patent No. 6,218,523, that shares priority with this application.

In response to the claim objections, claim 48 is amended to delete the reference to a polynucleotide probe and antisense sequences, Applicant preserves the right to present claims directed to these embodiments in a separate application claiming priority to the parent application(s) in this case.

The objection to the specification is overcome by the amendment to reflect the present priority status of the application and to indicate that application serial no. 09/036,315 is now USP 6,218,523.

Response to claim rejections under 35 USC § 112.

Claim 48 is amended to correct the ambiguity arising from the recitation of a recombinant polynucleotide encoding other species. The subject matter of a probe is resubmitted in independent fashion as new claim 57. The term Repro-PC-1.0 is replaced with the SEQ ID NO. in each claim as suggested by the Examiner. As is noted in the previous action, the recitation of language directed to variants and analogs of the Repro-PC-1.0 molecule, and the replacement with the SEQ ID NO., is performed to avoid the necessity to individually claim all of the polynucleotides encoding the individual variants and analogs that might vary in only insubstantially from the literal sequence of the listing, while performing the same function as the Repro-PC-1.0 molecule of SEQ ID NO.2. As is noted in the specification, a conservative substitution along the length of the polypeptide molecule can be made while preserving the structure and function of the molecule, however, such substitutions are

unforeseeable in the sense that each individual substitution, representing an insubstantial change from the polynucleotide molecule (encoding the polypeptide) of the sequence listing, cannot practically be claimed in the present application.

Response to rejections under 35 USC § 102.

Each of claims 43, 48, 49, and 50 are amended to require that the subject matter of the claim comprise at least 72 consecutive nucleotides of SEQ ID NO.1. To the extent these amended claims encompass a different molecule than the sequence disclosed by Hillier et al., the claims are not anticipated under 35 USC § 102. Similarly, the amended claims are not anticipated by Matsubara et al. for the same reason.

Response to double-patenting rejection.

Applicants recognize that the record before the Examiner indicates that the inventorship in the current application differs from USP 6,218,523. However, the requisite papers have been filed to correct inventorship in USP 6,218,523 pursuant to 35 USC § 256. The papers filed to correct inventorship in the '523 application are not materially different from the papers filed to correct inventorship in the present application and establish that an error was made without deceptive intent. Once inventorship is corrected in the '523 patent, the inventive entities in both the '523 patent and the present application will be identical.

Although the papers were filed substantially contemporaneously with the papers filed in the present application, the Patent Office has not acted on the papers despite the passage of many months and the submission of a status inquiry by Applicants' former counsel. Under the circumstances, Applicants submit that the threat to abandon the present application in the absence of a statement as to

which entity is the prior inventor of the conflicting subject matter is inappropriate given the non-final status of the present action, and the failure of the Patent Office to act in a timely manner to address the prior petition to correct inventorship. If the Examiner maintains the intent to abandon the application in the absence of a designation, please cancel the affected claims without prejudice.

Response to rejection under the judicially created doctrine of double patenting.

The double-patenting rejections of claims 39-40, 42-45, 48-50, and 56 is traversed by the terminal disclaimer filed herewith.

Response to rejection of pending claims under 35 USC § 103(a), in light of 35 USC § 102(f) and/or (g) in the absence of a showing of a common owner between the subject matter of the '523 patent and the present application.

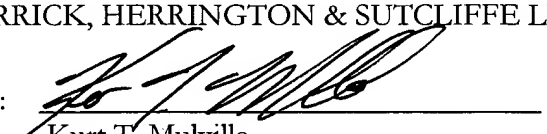
While the foregoing correction of inventorship should moot this issue, the present application, serial number 09/680,121 and USP 6,218,523 were both, at the time the invention of the present application was made, owned by Diagnostic Products Corporation.

Applicants submit that the pending claims are in condition for allowance and request such action accordingly.

Respectfully submitted,

ORRICK, HERRINGTON & SUTCLIFFE LLP

Dated: November 20, 2002

By: 

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MARKED-UP VERSION TO SHOW CHANGES MADE

IN THE CLAIMS:

Please amend the following claims:

43. A polynucleotide probe or primer of at least 72 [40] nucleotides that specifically hybridizes to a nucleotide sequence selected from Repro-PC-1.0 cDNA (SEQ ID NO:1) or its complement.

48. A recombinant polynucleotide comprising an expression control sequence operably linked to a nucleotide sequence encoding:

at least 72 consecutive amino acids of SEQ ID NO:2.[a Repro-PC-1.0 polypeptide,

a polynucleotide probe or primer of at least 40 nucleotides that specifically hybridizes to a nucleotide sequence selected from Repro-PC-1.0 cDNA (SEQ ID NO:1) or its complement, or

an inhibitory polynucleotide comprising an antisense sequence of at least 40 nucleotides that specifically hybridizes sequence selected from Repro-PC-1.0 cDNA (SEQ ID NO:1) and that inhibits expression of Repro-PC-1.0 in cells.]

49. A recombinant cell comprising a recombinant polynucleotide of claim 48 or 57.

50. A polynucleotide comprising at least at least 72 consecutive amino acids of SEQ ID NO:2.[40 consecutive nucleotides of SEQ ID NO:1.]